

## REMARKS

By this Amendment, claims 1-21, 23-32, 41, and 42 are canceled, and claim 22 is revised to place this application in condition for allowance. Claims 22 and 33 to 40 are pending in the above-identified application.

In the Non-Final office Action, claims 1-2, 4-9, 19, 22, 33, and 35-41 were rejected under 35 U.S.C §102(e) as being anticipated by United States Patent No. 5,978,013 to Jones et al (Jones). Claims 3 and 34 were rejected under 35 U.S.C §103 as being unpatentable over Jones when taken in view of United States Patent No. 5,931,905 to Hashimoto et al (Hashimoto). Claims 10, 31-32, and 42 were rejected under 35 U.S.C §103 as being unpatentable over Jones in view of United States Patent No. 5,287,181 to Holman. Claims 11-18 were rejected under 35 U.S.C §103 as being unpatentable over Jones in view of United States Patent No. 6,057,872 to Candelore.

Applicants respectfully traverse the rejections and submit arguments below in support of this traversal.

In review, claim 22, as amended, further defines the coupon indirect information and the decoding unit. While the Examiner contends that Jones teaches the features of claim 22, Applicants submit that this contention is in error, particularly when considering the revisions to claim 22. The question of anticipation is whether Jones teaches each and every limitation of claim 22, and this includes the coupon indirect information and the decoding unit. As will be explained below, these features are not found in Jones. Moreover, there is no basis to allege that Jones could be somehow modified to include the features of claim 22

and there is no basis to further reject this claim under 35 U.S.C. § 103(a).

Jones, as disclosed in cols. 4 and 5 and the abstract, teaches that coupon information is transmitted to a subscriber unit, and the coupon information is printed at the subscriber unit as a coupon.

More specifically, Jones teaches that a coupon packet and a coupon identifier are embedded in a video signal, and the video signal is transmitted to a subscriber unit 20.

At the subscriber unit 20, in response to a television viewer's request, searching occurs for the coupon identifier to be selected. The subscriber unit 20 monitors a received data channel to search coupon packets for any coupon packet that has a coupon identifier equal to the selected coupon identifier. If the subscriber unit 20 finds the coupon packet, the subscriber unit 20 reads coupon image bits of the packet, reconstructs a bit-mapped image based on the coupon image bits of the packet, and prints the reconstructed coupon.

In rejecting the claims, the Examiner alleges that the coupon identifier of Jones corresponds to "coupon indirect information" recited in claim 22. This contention is in error for a number of reasons. Claim 22 now defines the coupon indirect information as an encrypted coupon that is incapable of use. The decoding unit is one that decodes the coupon indirect information so that it can be used.

The Jones' coupon identifier is alone incapable of use for issuing a coupon without a received coupon packet within an available window. However, the "coupon indirect information" recited in claim 22 is now defined to include a coupon itself. In other words, the coupon identifier disclosed in Jones **does not** include a coupon used to select a coupon packet, and the coupon identifier is transmitted separately from coupon packets.

Put another way, the coupon identifier of Jones cannot be considered to be the coupon indirect information since the coupon indirect information is defined as having a coupon that is encrypted for later use. There is just no coupon in the coupon identifier of Jones and the limitation of claim 22 in this regard is missing from Jones. Therefore, anticipation under 35 U.S.C. § 102(e) cannot exist. Again, the "coupon indirect information" recited in claim 22 is clearly distinguished from the "coupon identifier" disclosed in Jones.

To reiterate, amended claim 22 includes coupon indirect information including a coupon with the coupon being encrypted to be incapable of use. This makes it possible to prevent the coupon included in the coupon indirect information from being printed or displayed unless performance of the predetermined operation.

In contrast and as described above, the coupon identifier disclosed in Jones **does not** include a coupon itself; it is the coupon packets disclosed in Jones that can be printed when desired. This is because, as described above, the Jones' coupon identifier is used to merely select a coupon packet, and Jones fails to disclose or suggest a coupon identifier's function of preventing a coupon from being printed or displayed as is recited in claim 22.

From this viewpoint, the Examiner points out, in the non-Final Office Action, that a television viewer can thus generate a coupon during the coupon available window. However, a skilled person in the art can recognize that the "television viewer" disclosed in Jones is a human television viewer. Jones discloses that the television viewer can get a coupon during the coupon availability window. Applicants submit however that the human viewer does not "generate" coupons. The human viewer may request a coupon but the actual generation of the coupon is not performed by the viewer, but the inner workings of

the system of Jones.

In Jones, the coupon identifier is used to only select a coupon packet, and the selected coupon packet is that which can be displayed or printed when desired.

In contrast, "decoding unit" recited in amended claim 22 is configured not to decode the coupon indirect information without any performance of the predetermined operation corresponding to the coupon indirect information; but to decode the coupon indirect information, upon performance of the predetermined operation corresponding to the coupon indirect information so as to issue the coupon which is decrypted to be capable of use.

Therefore, it is possible to prevent the coupon indirect information from being decoded unless any performance of the predetermined operation is created in the information broadcast receiving terminal apparatus.

Jones fails to disclose or suggest the configuration of the decoding unit recited in amended claim 22, and the advantage achieved by the configuration.

Based on the above, Jones cannot be said to establish a *prima facie* case of anticipation against claim 22, as amended. Therefore, the Examiner can only rely on 35 U.S.C. § 103(a) to further reject this claim, either by modifying Jones based on Jones own teachings of the secondary references cited to reject certain of the dependent claims.

Jones provides no reasoning that would support of modification of the Jones' system so as to arrive at the invention. This means that the Examiner needs to find this reasoning in the other cited references or withdraw the rejection.

The other cited references in the non-Final Office Action also fail to disclose or

suggest the subject matter of claim 22 set forth above. Therefore, even if Jones were modified according to the teachings of the other cited references, the invention of claim 22 would still not be taught or suggested and a *prima facie* case of obviousness would not exist.

It follows from what has been argued above that amended claim 22 is patentably distinguished over Jones and the other prior art references in combination or alone, and therefore, it is respectfully submitted that amended claim 22 is in condition for allowance.

The remaining claims 33 to 40 directly or indirectly depend on amended claim 22 and are therefore in condition for allowance at least by virtue of their dependency on amended claim 22.

All rejections having being addressed, withdrawal of the rejections is thus respectfully requested.

Accordingly, the Examiner is respectfully requested to examine this application and pass all pending claims onto issuance.

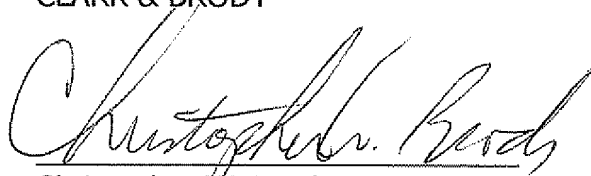
The above constitutes a complete response to all issues raised in the Office Action dated September 16, 2009.

If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

Again, reconsideration and allowance of this application is respectfully requested.

Applicants respectfully submit that there is no fee required for this submission, however, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,  
CLARK & BRODY

A handwritten signature in cursive script, appearing to read "Christopher W. Brody", written over a horizontal line.

Christopher W. Brody  
Registration No. 33,613

**Customer No. 22902**  
1090 Vermont Avenue, NW, Suite 250  
Washington, DC 20005  
Telephone: 202-835-1111  
Facsimile: 202-835-1755

Date: December 16, 2009